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Application No. 10/678,408

JUL 06 2007

REMARKS

The Office Action of March 6, 2007 has been received and reviewed. This response, submitted along with a Petition for One-Month Extension of Time, is directed to that Action.

The applicants would first like to extend their gratitude to the Examiner for the courtesy and consideration toward the applicant's attorney during a teleconference of June 12, 2007.

Although a binding agreement as to the scope of the claims was not reached, the Examiner offered very helpful suggestions in order to advance prosecution. The applicants believe the Examiner's suggestions have been incorporated in the claim amendments herein.

Accordingly, claims 1, 6, 8 and 18 have been amended, and claims 2, 3 and 17 have been cancelled. Support for the claim amendments can be found in the specification on page 28, lines 8-9; page 29, lines 8-9; page 30, lines 9-10; page 31, line 20; and page 32, line 23; and in claims 2 and 3 as originally filed. No new matter is believed to have been added.

The claim amendments herein are presented in order to advance prosecution of the instant application. In no way are they intended to limit the scope of any claim presented in a future continuation or divisional application that makes a priority claim to the instant application.

The applicants respectfully request reconsideration based on the foregoing amendments and the following remarks.

Claim Rejections- 35 U.S.C. §103

The Examiner rejected claims 1-3, 10, 14, 15, 17 and 18 under 35 U.S.C. §103(a) as obvious over the "Horodysky references" (US 4,389,322; 4,478,732; or 4,594,171) or Doner et

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al. (US 5,068,045) in view of Karol (US 5,055,584) or Karol (4,761,482). Furthermore, the Examiner made the following additional rejections: claims 1-3, 6-9 and 16-18 under 35 U.S.C. §103(a) as obvious over the Horodysky references or Doner in view of Nakazato et al. (5,629,272), claims 1-3, 11, 16-18 under 35 U.S.C. §103(a) as obvious over the Horodysky references or Doner in view of either Holt et al (US 6,187,723) or Atherton (US 5,925,600), and claims 1-3, 12-13, 16 and 18 are rejected under 35 U.S.C. §103(a) as obvious over the Horodysky references or Doner in view of Rowan (US 4,889,647).

The Examiner stated that the Horodysky references and Doner disclose an organo borate ester composition in the form of borated derivatives of ethoxylated amides which are effective friction reducing additives for lubricating oils. The Examiner further stated that the component (2) additives of the present claims are known as conventional additives in the lubricating oil art, and additionally that the secondary references teach the additives of component (2). In response to the Declaration and remarks submitted by the applicant in the response dated December 15, 2006, the Examiner stated that the data presented in said Declaration was not commensurate in scope with the claimed invention because, while the claims were not limited specifically to the additives which were tested in the data presented in the Declaration. Accordingly, the Examiner maintained the rejection under 35 U.S.C. §103(a). The applicants respectfully traverse these rejections.

Indeed, the presently claimed invention exhibits unexpected results when an organo borate ester additive according to claim 1 is combined with any of the additives of component (2) in an amount according to the claimed ratio. This is clearly set forth in data in the specification.

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Furthermore, the first paragraph on page 27 of the specification as filed clearly explains that while high concentrations of borate ester alone (1% by mass or greater in relation to the lubricating composition as a whole) provide adequate antiwear protection, lower amounts of the same borate ester used alone lead to significantly inferior antiwear performance (Table A; Table 1, compare tests 1 and 10).

However, in the presently claimed invention it was surprisingly discovered that acceptable antiwear results can be achieved even when using low amounts (<1% by mass) of organo borate ester if combined, according to the claimed ratio, with the additive of component (2). This synergy can be clearly seen in the data presented in the specification. There is nothing in the prior art references cited in the present Office Action that suggests that such a synergy is possible. Accordingly, the applicants submit that a *prima facie* case of obviousness cannot be established in view of the unexpected synergy. Therefore, the applicants respectfully request that the present rejections be withdrawn.

The claim amendments herein are presented in order to advance prosecution of the present application. In no way are they intended to limit the scope of any claim presented in a continuation or divisional application that claims priority to the instant application.

The applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263

Respectfully submitted,  
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